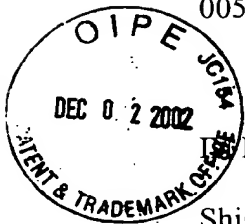


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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

RE APPLICATION OF:

Shigenobu MAEDA et al.

SERIAL NO: 09/429,283 ✓

FILED: October 28, 1999 ✓

FOR: SEMICONDUCTOR DEVICE AND
METHOD OF MANUFACTURING
THE SAME

:

: GROUP ART UNIT: 2823

:

: EXAMINER: G. FOURSON, III

TC 2800 MAIL ROOM

RECEIVED
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REPLY BRIEF

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Applicants respectfully reply to the October 02, 2002 Examiner's Answer regarding the above identified application as provided for below.

VI. ISSUES

Applicants agree that the rejections of claims 14-27 under 35 USC 103(a) is based on "Kuroi et al." and not "Kurol et al.".

VIII. REPLY ARGUMENT

Page 6, lines 11-13 of the Examiner's Answer (hereinafter "EA") argues that "one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references." In reply, Applicants point out that in order to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The cited prior art references, alone or in combination, do not teach or suggest all of the features of claim 14. This is evident and apparent, as none of the cited prior art references disclose, teach, or

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suggest the step of introducing an impurity into a polysilicon layer within a first region and a second region, wherein the impurity in the first region is at a relatively low dose and the impurity in the second region is at a relatively high dose.

Page 6, lines 15 and 16 of the EA argues that because a reference contains “teachings in addition to those relied on [does] not negate the teachings relied on.” In response, Applicants point out that references have to be analyzed for what they teach one of ordinary skill in the art. If one passage clarifies another passage, then Applicants submit that both passages have to be considered when determining the scope of the teaching of the reference.

Page 7 lines 2 and 3 of the EA argue that “In this case, all references are drawn to a MOSFET formation and are thus analogous.” In response, Applicants point out that just because the applied references are from “analogous” fields does not negate the requirement that motivation must be shown in order to combine under 35 USC 103(a). Further, there must be a particular finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge to the claimed invention to combine or modify references. *In re Kotzab*, 217 F.3d 1365, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000). Also, see M.P.E.P. §2143. The FR fails to make such a finding.

CONCLUSION

The FR clearly fails to present a *prima facie* case as to obviousness. Therefore, reversal of all rejections is believed to be in order.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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